

Appl. No.: 09/500,224  
Docket No.: 1982-0143P  
Reply to Office Action of February 11, 2004

REMARKS

Claims 1-23 are pending in this application. Claims 1, 7 and 14 are independent claims. By this amendment, claims 1, 7 and 14 are amended and new claims 21-23 are added. Reconsideration in view of the above amendments and following remarks is respectfully solicited.

The Claims Define Patentable Subject Matter

The Office Action makes the following rejections:

(1) claims 1, 2, 7, 8, 14 and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,603,102 to Rebec et al. (hereafter Rebec);

(2) claims 3, 4, 9, 10, 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rebec in view of U.S. Patent No. 5,879,289 to Yarush et al. (hereafter Yarush);

(3) claims 5, 11 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rebec in view of Japanese Patent No. 410042231A to Hatori (hereafter Hatori);

(4) claims 6, 13 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rebec in view of Hatori and further in view of U.S. Patent NO. 4,523,825 to Norris (hereafter Norris); and

(5) claims 12 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rebec in view of U.S. Patent No. 6,642,959 to Arai (hereafter Arai).

These rejections are respectfully traversed.

Applicant respectfully submits that all of the cited references, either alone or in combination, fail to teach or

suggest each and every feature as set forth in the claimed invention.

Rejections under 35 U.S.C. §102(b)

The claimed invention is at least directed towards a recyclable/reusable digital camera that includes a communication section that is capable of outputting image data to an external device via infrared radiation. A removable protection cover covers the communication section. When data is ready to be outputted from the communication section, the protection cover is removed, thus exposing the transmitting port of the communication section. After the image data is taken out, the communication section is once again covered by the protecting cover, thereby resetting the camera for another use.

In contrast with the present invention, Rebec is merely directed towards a portable satellite communication system with a housing. In other words, Rebec includes a transmission system 410 at a first location that communicates with a receiving system 420 at a second location via a satellite 20. (see Rebec, col. 8, lines 32-36).

Rebec's transmission system 410 includes an interface unit 430 that receives an analog signal and an analog video signal and transforms that analog audio/video signal into a digital red, green, blue (RGB) signal. A microwave transmitter 460T transmits a modulated L-band microwave signal to satellite 20 that receives the L-band microwave signal and transmits that signal to receiving system 420. (see Rebec, col. 8, line 42 to col. 9, line 7).

It appears that the Examiner is associating Rebec's transmission system 410 with the claimed communication section and is associating Rebec's satellite 20 with the claimed external device. (see Office Action, page 2).

However, applicant respectfully submits that the claimed communication section is distinguishable from Rebec's transmission system 410 in that the claimed communication section is incorporated into a digital camera. On the other hand, Rebec's transmission system 410 is not designed as a part of a digital camera but is instead a separate unit that merely can receive data from a camera. (see Rebec, col. 8, lines 46-48).

Furthermore, Rebec's transmission system 410 transmits by using microwave signals, whereas the present invention indicates that the communication section utilizes infrared radiation.

The Examiner further alleges that the claimed protecting means is disclosed in Rebec's housing 700. (see Rebec's Figs. 7A and 7B). Rebec discloses that suitcase or housing 700, with lid 710, can house the transmission system 410. (see Rebec, col. 12, lines 27-38). Furthermore, Rebec discloses that the housing can be used to shield the communication system from microwaves. (see Rebec, col. 4, lines 54-56). For these reasons, the Examiner is interpreting Rebec's housing/suitcase 700 as a protecting means.

However, applicant respectfully submits that the claimed protecting means is distinguishable from Rebec's housing 700 in that the protecting means in the present invention discloses that the protective means is used to cover the communication section of

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a digital camera, whereas Rebec's housing 700 fails to be associated with a digital camera wherein it covers a communication section of such camera.

Rebec's housing 700 merely represents a suitcase for carrying various equipment of the communication system. On the other hand, in the present invention a more contouring cover for covering the outer surface of the communication section of a digital camera is used as the housing. (see applicants' Fig. 1 and claims 1, 7 and 14).

Finally, a key aspect of the present invention is the ability to be reusable. None of the cited references teach or suggest reusability, as set forth in claims 1, 7 and 14, wherein the communication section is reset. This feature amplifies the recycling/reusability of the present invention.

For at least the above noted reasons, applicant respectfully submits that the present invention is distinguishable from Rebec.

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis*

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*verbis test*, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 ( Fed. Cir. 1990).

Applicant respectfully submits that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, Rebec, fails to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claims 1, 7 and 14 allowable over Rebec for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1, 2, 7, 8, 14 and 15 under 35 U.S.C. §102(b) is respectfully solicited.

Rejections under 35 U.S.C. §103(a)

Applicant also respectfully submits that each of Yarush, Hatori, Norris and Arai, either alone or in combination, fail to make up for the deficiencies found in Rebec as noted above.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

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claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

For instance, like Rebec, each of the secondary references noted above also fail to disclose a digital camera including a communication section, protecting means that substantially contour to the communication section and resetting of the communication section. For example, the Examiner alleges that Yarush's housing 202 is sheet-shaped and elastic in nature because Yarush discloses that it may be waterproof by disposing a rubber grommet or O-ring around it. (see Office Action, page 4). However, Yarush fails to disclose the housing 202 as substantially contouring the communication section. Instead, Yarush's housing 202 houses the light source means, video imaging means, lens means, and the power supply means such that the apparatus is self-contained. (see Yarush, col. 15, lines 50-53). In other words, it appears that Yarush's housing 202 is just like Rebec's suitcase which is for encasing the entire system, not for covering the communication section.

Again, applicant respectfully submits each one of the secondary references, i.e., Yarush, Hatori, Arai and Norris, fail to make up for the deficiencies noted above found in Rebec.

Applicant respectfully submits that not only does the cited references fail to teach or suggest each and every feature as set forth in the claimed invention, but that one of ordinary skill in

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the art would not have been motivated to combine/modify the teachings of Rebec with the numerous secondary references because there is no teaching or suggestion in any of the references regarding how or why one would modify such systems to arrive at the claimed invention.

Applicant respectfully submits that dependent claims 3-6, 9-13 and 16-20 are allowable over Rebec in combination with the secondary references for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 3-6, 9-13 and 16-20 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a

Personal Interview.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,  
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